



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087474,450	06/07/95	SHUBER	0372/08128

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

18M2/1017

EXAMINER

TUNG, J

ART UNIT	PAPER NUMBER
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1807

12

DATE MAILED:

10/17/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
08/474,450Applicant(s)
ShuberExaminer
Joyce TungGroup Art Unit
1807

THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 6 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on June 13, 97 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
 - ☒ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: please see the attached.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The new argument raises the new issue.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-18

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

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Response to Amendment

1. The 35 U.S.C. 112 first paragraph rejection over claims 17 and 18 in paragraph 8 of paper N0.10 of the Office action mailed 6/13/97 is withdrawn in light of the amendments of the response filed 9/15/97.
2. The 35 U.S.C. 132 objection of the amendment filed 2/10/97 which introduced new matter in claims 17 and 18 in paragraph 7 of paper N0.10 of the Office action mailed 6/13/97 is withdrawn in light of the amendments of the response filed 9/15/97.
3. Proposed amended claims 1 and 14 contain the limitation "common sequence (oligonucleotide) not comprising a restriction enzyme recognition site sequence" which requires further consideration and search. Further this limitation raises the issue of new matter, as support has not been pointed out in the specification. Therefore, the amendment has not been entered.
4. The 35 U.S.C. 103 rejection over claims 1-12 made in paragraph 5 of the Office action mailed 6/13/97 is maintained. The arguments of the response filed 9/15/97 have been fully considered, but are not found persuasive because the response raises new issue. Additionally, the same rejection is also made over claims 13 and 17. The reason is the same as in the Office action mailed 10/9/96 and 6/13/97.
5. No claims are allowable over the prior art.

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6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152. The fax number for Art Unit 1807 is (703)305-7401.

Any inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

October 15, 1997